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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/760,453	01/21/2004	Yousuke Kumaki	247776US0X	1386
22850	7590	02/10/2005	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			REDDICK, MARIE L	
		ART UNIT	PAPER NUMBER	
		1713		

DATE MAILED: 02/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/760,453	KUMAKI ET AL.	
	Examiner	Art Unit	
	Judy M. Reddick	1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 08/30/04 & 11/16/04.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 10-27 is/are pending in the application.
- 4a) Of the above claim(s) 11 and 13 is/are withdrawn from consideration.
- 5) Claim(s) 10, 12 and 14-27 is/are allowed.
- 6) Claim(s) _____ is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) 11 and 13 are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>08/30/04</u> | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1713

DETAILED ACTION

Response to Amendment

1. The amendment coupled with the persuasive arguments of Counsel filed on 11/16/04 are sufficient to overcome the rejection under 35 USC § 102 (b)/103 (a) over EP 799,712 A1 as applied to claims 1-7 (07/02/04, paragraph no. 5) and the rejection under 35 USC § 103 (a) over EP 799,712 A1 as applied to claims 8 & 9 (07/02/04, paragraph no. 9).

Election/Restrictions

2. Newly submitted claims 11 & 13 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the originally presented invention was drawn to a polyvinyl acetal, a binder for ink or paint which comprises a polyvinyl acetal, ink or paint containing, as a binder, a polyvinyl acetal and a ceramic green sheet formed with a binder comprising a polyvinyl acetal vs newly submitted claims 11 & 13 which are drawn to a process of producing an ink or paint (11) and a process of producing a ceramic green sheet (13). The inventions are separate and distinct, each from the other, as per having been related as product and process of making. The products (ink or paint and ceramic green sheet), as claimed, can be made by a materially different process such as a process that involves forming the polyvinyl acetal insitu.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 11 & 13 have been withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Information Disclosure Statement

3. The information disclosure statement filed 08/30/04 has been considered and scanned into the application file.

Allowable Subject Matter

4. Claims 10, 12 and 14-27 are deemed allowable over the prior art to EP 799,712 A1 as per reasons clearly stated in Counsel's REMARKS (11/16/04, pages 7 & 8). Furthermore, the instantly claimed invention is deemed allowable over the prior art to Pinschmidt, Jr. et al (U.S. 5,086,111) who teach the use of polyvinyl acetals derived from the acetalization of a hydrolyzed copolymer of vinyl acetate and an N-vinylamide as flocculants and protective colloids as per one having ordinary skill in the art

would not have been endowed with any motivation to use the polyvinyl acetals in formulating an ink or paint or a ceramic green sheet with any reasonable expectation of success.

5. This application is in condition for allowance except for the following formal matters:

The presence of non-elected claims 11 & 13.

Prosecution on the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213.

A shortened statutory period for reply to this action is set to expire TWO MONTHS from the mailing date of this letter.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (571) 272-1110. The examiner can normally be reached on 6:00 a.m. - 2:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Judy M. Reddick
Judy M. Reddick
Primary Examiner
Art Unit 1713

JMR
02/04/05